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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,964	10/04/2004	Shoichi Ishikawa	1391.1061	1007
21171	7590	02/24/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ADAMS, CHARLES D	
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DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/509,964	<b>Applicant(s)</b> ISHIKAWA ET AL.	
	<b>Examiner</b> Charles D. Adams	<b>Art Unit</b> 2164	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-4-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the same environment" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the electronic mail software" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-6 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.1.(a)**

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

Claims 1-6 and 8, in view of the above cited MPEP sections, are not statutory because they merely cite a number of computer steps. The use of a computer has not been indicated. As to claim 8, the "program executing the steps" lacks usefulness, because though a program executes the steps, a computer is not claimed as executing the steps.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 3, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (US Patent 6,073,137).

As to claim 1, Brown et al. teaches a file management method for reading and filing documents by use of file management software, comprising the steps of:

Analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration (see column 6, lines 1-4 and column 6, lines 24-26. The remote mail sever contains folder configurations. It is inherent that the folder configurations that contain messages on a 'mail server' were created with 'mail software');

Creating the same folder configuration in a file system on the basis of the obtained information (see 6:24-32 and 6:55-58. "The retrieved data is used to synchronize child folders so that the displayed list of child folders matches the list from the server". The local version of the folder configuration is created in "Microsoft Outlook 98" (see 5:1-9). "Microsoft Outlook 98" provides a system of organizing messages (files). Thus, the folder configuration is created in a file system); and

Performing file management by executing filing processing for the created folder configuration (see 6:58-65. The created folder is processed to correctly display subfolder indicia. Brown et al. also makes use of "Microsoft Outlook 98" (see 5:1-9), which provides for 'file processing').

As to claim 2, Brown et al. teaches wherein the analysis of the folder configuration is performed at the time of startup of the file management software, regularly, or upon user's requests (see 6:5-6. Analysis is performed upon a user request (expanding a folder)); and

When the folder configuration of the mail software differs from that of the file system, the folder configuration of the file system is updated to match that of the mail software (see 6:55-58).

As to claim 3, Brown et al. teaches wherein mail data items are obtained from the mail software and are stored in corresponding folders created in the file system (see 6:24-32); and mail data and other files are managed in the file system under the same environment (see 5:1-9).

As to claim 7, Brown et al. teaches a file management system for reading and filing documents by use of file management software, comprising:

A folder configuration created on mail software in order to obtain information regarding the folder configuration (see column 6, lines 1-4 and column 6, lines 24-26. The remote mail sever contains folder configurations. It is inherent that the folder configurations that contain messages on a 'mail server' were created with 'mail software'); and

A folder configuration creation section for creating the same folder configuration in a file system on the basis of the information obtained by the folder configuration analysis section (see 6:24-32 and 6:55-58. "The retrieved data is used to synchronize child folders so that the displayed list of child folders matches the list from the server". The local version of the folder configuration is created in "Microsoft Outlook 98" (see

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5:1-9). "Microsoft Outlook 98" provides a system of organizing messages (files). Thus, the folder configuration is created in a file system),

Wherein file management is performed by executing filing processing for the file folder configuration created by the folder configuration creation section (see 6:58-65. The created folder is processed to correctly display subfolder indicia. Brown et al. also makes use of "Microsoft Outlook 98" (see 5:1-9), which provides for 'file processing').

As to claim 8, Brown et al. teaches a file management program for reading and filing documents by use of file management software, the program executing the steps of:

Analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration (see column 6, lines 1-4 and column 6, lines 24-26. The remote mail sever contains folder configurations. It is inherent that the folder configurations that contain messages on a 'mail server' were created with 'mail software');

Creating the same folder configuration in a file system on the basis of the obtained information (see 6:24-32 and 6:55-58. "The retrieved data is used to synchronize child folders so that the displayed list of child folders matches the list from the server". The local version of the folder configuration is created in "Microsoft Outlook 98" (see 5:1-9). "Microsoft Outlook 98" provides a system of organizing messages (files). Thus, the folder configuration is created in a file system); and

Performing file management by executing filing processing for the created folder configuration (see 6:58-65. The created folder is processed to correctly display subfolder indicia. Brown et al. also makes use of "Microsoft Outlook 98" (see 5:1-9), which provides for 'file processing').

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks (US Pre-Grant Publication 2003/0033271).

As to claim 1, Hendricks teaches a file management method for reading and filing documents by use of file management software, the comprising the steps of:

Analyzing a folder configuration created on mail software in order to obtain information regarding the folder configuration (see paragraph [0020]. Information for transferring files and folders from user A to user B is analyzed and stored in a transfer database);



Creating the same folder configuration in a file system on the basis of the obtained information (see paragraph [0028] and [0029]. The mail messages (files) are recreated with the hierarchy intact. As this is a method of organizing files, it is a file system); and

Performing file management by executing filing processing for the created folder configuration (see paragraph [0029]).

As to claim 5, Hendricks teaches wherein the folder configuration of the electronic mail software is created on two or more storage units (see paragraphs [0030]. Folders can be transferred to more than one user. Therefore, the folder configuration of the electronic mail software can be created on two or more storage units).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US Pre-Grant Publication 2003/0033271) in view of Sykes, JR. (US Pre-Grant Publication 2002/0129108).

Hendricks teaches a file management method according to claim 1.

Hendricks doesn't teach wherein when a file is stored in a folder in the file system, a mail including information regarding a link to the file, detailed information of the file, and the file itself is transmitted to a mail address of a user, whereby the file is managed on the mail software.

Sykes, JR. teaches wherein when a file is stored in a folder in the file system, a mail including information regarding a link to the file, detailed information of the file, and the file itself is transmitted to a mail address of a user, whereby the file is managed on the mail software (see Figures 2a and 2b, paragraphs [0010] and [0011]). When a message from the mail software is stored in the alternate file system, the system transmits a receipt to the sender that includes the original message (file). The receipt includes information regarding a link (a sender is told that it exists and is archived), detailed information of the file (the original message), and, as stated, the original message itself. As the receipt is transmitted to the user via email, the user may then manage the file on his or her email software).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Hendricks by the teaching of Sykes, JR because Sykes, JR teaches that "a problem with electronic communications versus their paper-based counterparts is that some electronic communications can be altered, sometimes without detection, and thus it is difficult to verify what was sent, when it was sent, or when it was received".

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11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US Pre-Grant Publication 2003/0033271) in view of Johnson et al (US Patent 6,248,996).

Hendricks teaches a file management method according to claim 5.

Hendricks does not teach wherein image data read by use of a scanner are simultaneously stored in the two or more storage units.

Johnson et al. teaches wherein image data read by use of a scanner are simultaneously stored in the two or more storage units (see 2:27-31 and 2:47-50).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Hendricks by the teaching of Johnson et al., since Johnson et al. teaches that "if the user has even a few destinations for one document, the process of serially re-scanning and re-transmitting for each destination can be cumbersome and time consuming. This is especially true for multi-page documents, since each page of the document would have to be scanned for each receiver destination. Therefore, the need exists to provide a more user-friendly scanner that simplifies the task of sending a job to one or more heterogeneous receivers for the user" (see 2:20-24).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles Adams  
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**SAM RIMELL**  
**PRIMARY EXAMINER**